REMARKS

Claims 47, 50 - 53, 56 - 59, 62 - 65, 68 - 71, and 74 - 78 are pending in the present application.

This Amendment is in response to the office action mailed September 8, 2003. In the Office Action, the Examiner rejected claims 47, 52, 59, and 64 under 35 U.S.C. § 102(e) and claims 50, 51, 53 - 56, 58, 62, 65 - 67, and 69 - 77 under 35 U.S.C. § 103. Applicant has canceled claims 54, 55, 66, 67, 72, and 73 and amended claims 47, 51, 53, 59, 65, 71.

Reconsideration in light of the amendments and remarks made herein is respectfully requested.

REJECTIONS UNDER 35 U.S.C. § 102

In the Office Action, the Examiner rejected claims 47, 52, 59, and 64 under 35 U.S.C. § 102(e) as being anticipated by U.S. Pat. No. 5,822,291 issued to Brindze et al. ("Brindze"). Applicant respectfully traverses the rejections for the following reasons.

Brindze discloses a mass storage element and drive unit. The use of an auxiliary area in a mass storage element for identification use is discussed. The identification methods discussed in Brindze include the use of a bar code or magnetic strip. However, there is no discussion of using the burst cut area (BCA). To support a 102 rejection, the Examiner must show that "each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros., Inc. v. Union Oil Co., 814 F.2d 628, 631 (Fed. Cir. 1987), (MPEP §2131). In addition, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." Richardson v. Suzuki

Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989), (MPEP §2131). Here, as the Examiner has already disclosed in the current office action as well as in previous office actions, there is no specific language in Brindze that teaches the use of an identifier on a burst cut area. Therefore, Brindze taken alone or in any combination, does not disclose, suggest, or render obvious.

Since Brindze fails to disclose the identical invention in as complete detail as is contained in the claim, the rejection under 35 U.S.C. §102(e) is now improperly made. Therefore, Applicant respectfully requests that rejection be withdrawn.

REJECTIONS UNDER 35 U.S.C. § 103

The Examiner rejected claims 50, 53 - 56, 58, 62, 65 - 67, and 69 - 77 under 35 U.S.C. § 103(a) as being unpatentable over Brindze in view of EP 0802527 A1 issued to Oshima et al. ("Oshima"). The Examiner also rejects claims 51 and 62 under 35 U.S.C. § 103(a) as being unpatentable over Brindze in view of U. S. Pat. No. 6,052,465 issued to Gotoh et al. ("Gotoh"). The Examiner further rejects claims 57 and 68 under 35 U.S.C. § 103(a) as being unpatentable over Brindze in view of Oshima in further view of Gotoh. Applicant respectfully traverses the rejections for the following reasons.

Brindze is described *supra*. Oshima discloses an optical disk, optical recorder, optical reproducing device, encrypted communication system, and authorizing system for use of programs. Gotoh discloses an optical disk, an optical disk barcode forming method, an optical disk reproduction apparatus, a marking forming apparatus, a method of forming a laser marking on an optical disk, and a method of manufacturing an optical disk.

As the Examiner states in the current Office Action, Brindze does not disclose the use of an identifier in the BCA. Oshima does not disclose the use of pertinent user information combined with an identifier in the BCA. Oshima requires the use of a cipher and does not request pertinent user information. In addition, Oshima requires two methods of modulation, one method being different from the first. Oshima describes one method of modulation used to incorporate the data on the disk and another method to incorporate an identifier. The current invention does not require two methods of modulation. The teachings of more than one reference may be considered in combination, but only when there is some teaching or suggestion to support their use in the combination. Smithkline Diagnostics, Inc. v. Helena Laboratories Corp., 859 F.2d 878, 886-887, 8 U.S.P.Q.2d 1475. At present, there is nothing disclosed in either Brindze or Oshima which teaches or suggests combining the references.

Gotoh discloses using a bar code to identify a disk. It does not disclose the use of an identifier located in a BCA. There is nothing in Gotoh, which suggests the use of a BCA to locate an identifier in place of a bar code or to combine it with a reference that uses a BCA. The use of a barcode is a completely a different technology from the one disclosed in the current invention. The teachings of more than one reference may be considered in combination, but only when there is some teaching or suggestion to support their use in the combination, *supra*. There is nothing disclosed in either Brindze or Gotoh which motivates combining the two references.

Brindze, Oshima, and Gotoh, taken alone or in any combination, do not disclose, suggest, or render obvious. Therefore, Applicant believes that independent claims 47, 53, 59, 65, and 71 and their respective dependent claims

are distinguishable over the cited prior art references. Accordingly, Applicant respectfully requests the rejections under 35 U.S.C. § 102(e) and § 103(a) be withdrawn.

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CONCLUSION

In view of the amendments and remarks made above, it is respectfully submitted that the pending claims are in condition for allowance, and such action is respectfully solicited. If it is believed that a telephone conversation would expedite the prosecution of the present application, or clarify matters with regard to its allowance, the Examiner is invited to contact the undersigned attorney at the number listed below.

Respectfully submitted,

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Dated: November 6, 2003

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